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09/810,074	03/15/2001	John M. Hall	10004376-1	9131

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT PAPER NUMBER

2154

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/810,074

Applicant(s)

HALL ET AL.

Examiner

Ashok B. Patel

Art Unit

2154

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 February 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet..

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Continuation Sheet:

Applicant's argument:

Reply to Examiner's Response to Arguments:

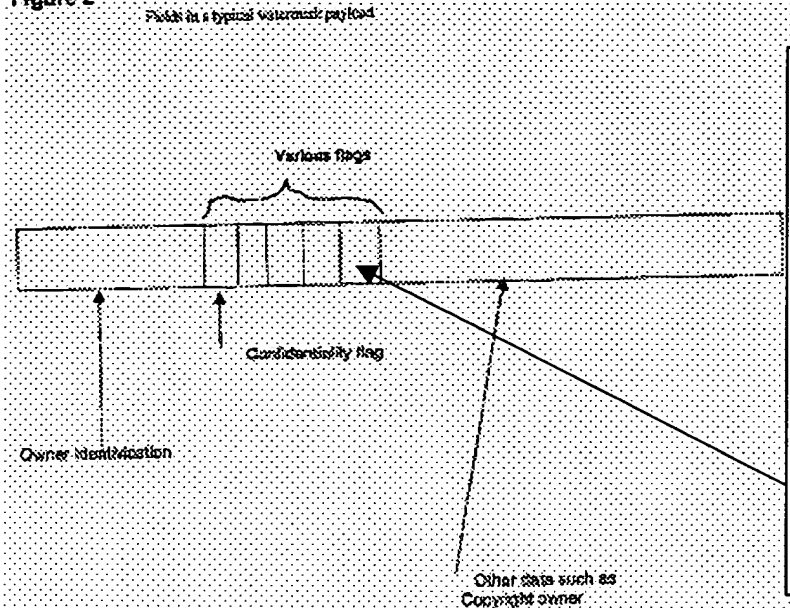
"Thus, since the digital watermark is not even in a human-readable form, the digital watermark itself and the flag bits encoded therein, do not provide any indication to recipients regarding destinations of a network communication, and certainly do not "indicate to recipients whether the first network communication is directed only to destinations internal to the company", as recited in independent claim 1."

"Thus, like Biliris, Jones also does not teach or suggest "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed only to destinations internal to the company", as recited in independent claim 1."

"As shown above, there is nothing in the disclosure regarding the data base 401 that teaches or suggests comparing destination information in a network communication to information in a company directory of a directory server, or determining whether a network communication is directed to a destination that is internal to a company based on such a comparison."

Examiner's response:

Figure 2



As stated earlier, Jones at para.[0017] teaches "The data fields and flags in a typical watermark payload are shown in FIG. 2. It should be understood that the fields and flags shown are merely representative and they can take many alternative forms. The first embodiment of the invention utilizes one of the flag fields to indicate that a particular document is confidential. The other fields can be used in a conventional manner. Alternate embodiments can use a number of flags to indicate actions that should be taken with a particular message.

Further, at para. [0020] and [0021], Jones teaches "The system could merely check the sender against this list or alternatively, the system could require that a password be entered when such messages are encountered. The table above shows only three flag bits. A system could have more or less flag bits as the needs of the particular system require. [0021] The important point is that the system considers the message sender, the message recipient and the condition of the flags in the data carried by a digital watermark to determine what action should be taken."

Thus, Jones teaches "adding an identifier to the first network communication to indicate to recipients whether the first network communication is directed to at least one destination internal to the company."

Now, as part of "what action should be taken", Jones teaches at para.[0020] the following database:

Sender Group	Recipient Group	Flag Conditions	Action
S1	R1	011	Send message
S1	R2	110	Do not send message notify the administrator
S1	R2	001	Send message, and log fact that S1 sent a message to R2.
S1	R2	101	Return message to sender
S2	R1	011	Send message
S2	R3	110	Do not send message and notify the system administrator

And further elaborating on the above database, Jones elucidates at para.[0020], "It should be clearly noted that the above is merely a simplified example of the rules and combinations that could be in data base 401. The databases could include hundreds or thousands of users and it could include dozens of rules. The system can be complex or simple as desired for a particular application. A system can include many alternatives in addition to those shown above or a system might include only a very few alternatives. For example, the system could include only a list of addresses which are authorized to receive messages which have a confidentiality flag set to "confidential". Such a system would allow confidential documents to be only sent to selected addresses."

The intent providing the proper context for the invention's implementation is clearly declared by Jones as disclosed in para.[0003] and [0004], as being "[0003] The Internet presents security challenges to corporations and others who have computers which store confidential information and which have connections to the internet. Traditionally, documents containing confidential information are marked with a legend or other visual indicia with words such a "CONFIDENTIAL", "PROPRIETARY", etc. The presence of these marks alert anyone handling such documents that they

Art Unit: 2154

should only be transferred outside of company under special precautions. It is relatively difficult and unusual for someone to inadvertently manually send such a document to an unauthorized receiver. However, the use of Internet communication changes the situation. [0004] The Internet and electronic mail speeds the communications process; however, the Internet and electronic mail also make it much easier to inadvertently or accidentally send a confidential document to an unauthorized receiver. A single accidental or inadvertent keystroke can have wide ranging unintended consequences. The Internet and other electronic communication system make it easy to communicate; however, these systems and networks also makes it easy to mistakenly or inadvertently sent a document to the wrong party."

Thus, Jones teaches "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory".

As indicated above database 401 contains the information needed for comparison as stated below by Jones:

Para.[0019], The data base 401 contains a list of different potential message senders, a list showing different groups of potential message recipients, and a set of possible categories indicated by the setting of the various flags in a message."

And in para.[0020], "The system could merely check the sender against this list or alternatively, the system could require that a password be entered when such messages are encountered. The table above shows only three flag bits. A system could have more or less flag bits as the needs of the particular system require."

Applicant's argument:

35 U.S.C. §103 Rejections:

"In view of the above, independent claim 1 is not taught or suggested by Biliris and Jones, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 1 under 35 U.S.C. § 103(a), and requests allowance of this claim."

Examiner's response:

Please refer to the teachings of Jones as stated above.

Applicant's argument:

"Independent claim 15 includes the limitation "a controller configured to performcompany." The Examiner stated that "claim 15 is rejected for the reasons set forth for claim 1 ." (Final Office Action at para. no. 4, page 12). For the reasons set forth above with respect to independent claim 1, Biliris and Jones do not teach or suggest the above- quoted limitations of independent claim 15."

Examiner's response:

Please refer to the teachings of Jones as stated above in conjunction with Fig. 4, elements 305-407" including the database 401 provides "a controller".

Applicant's argument:

"The Examiner is relying on the disclosure in Jones related to multiple network devices, including user terminals 301 and email server 302. However, there is no teaching or suggestion in Jones that any of the user terminals 301 includes a controller configured to perform a search of the directory servercompany. There is also no teaching or suggestion in Jones that the email server 302 includes a controller

Art Unit: 2154

configured to perform a search of the directory server based on the received....company.”

Examiner's response:

Please refer to the teachings of Jones as stated above in conjunction with Fig. 4, elements 305-407” including the database 401 provides “a controller”. Also refer to Fig. 3, “elements 302, 303 and 305 in conjunction with Jones teachings in para.[0018].

Applicant's argument:

“The Examiner stated that “claim 18 is rejected for the reasons set forth for claim 1.” (Final Office Action at para. no. 4, page 12). For the reasons set forth above with respect to independent claim 1, Biliris and Jones do not teach or suggest the above-quoted limitations of independent claim 18.”

Examiner's response:

Please refer to the response provided for claims 1 and 15 above.